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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,012

03/16/2004

Ivan To

THOLAM P226US

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EXAMINER

MILLER, WILLIAM L

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,012	<b>Applicant(s)</b> TO, IVAN	
	<b>Examiner</b> William L. Miller	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10,12,13,15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) 12,13,17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,15 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080707</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07-07-2008 has been entered.
2. The supplemental amendment filed 07-24-2008 has been entered.
3. Claims 10, 12, 13, 15, and 17-23 are pending.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 03-18-2003. It is noted, however, that applicant has not filed a certified copy of the Canadian application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

5. The information disclosure statement filed 07-07-2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Election/Restrictions***

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6. Claims 12, 13, 17, and 18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03-15-2006.

***Claim Objections***

7. Claim 15 is objected to because of the following informalities: line 3, after "light" insert -source--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 19 appears redundant with claim 15 and fails to further limit.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 10, 15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. (US#6843010).

12. Regarding claim 10, Robinson discloses a luminescent signage component comprising: a one piece body 12 in the form of a sign plate made from a single layer of transparent material,

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having a first face 17 and an opposing second face; at least one inlaid cavity 22 (etched character) in the body defining one of alpha-numeric indicia or graphic indicia, and the at least one cavity being closed by an integrally formed transparent window (portion) positioned across the second face; luminescent epoxy 16 filling the at least one cavity (col. 2, lines 56-59), such that the one of alpha-numeric indicia or graphic indicia emits a luminescent glow in the event of a power failure; and a constant light source 14 backlighting via reflection the at least one inlaid cavity. The first face 17 is being viewed and labeled as an "exterior" face, while the opposing second face is being viewed and labeled as an "interior" face as these faces meet the claim limitations. It is noted the faces have no reference to limit the labeling of the faces of the sign plate. The cavity extends a distance "substantially" midway between the faces.

13. Regarding claim 15, Robinson discloses an exit sign comprising: a sign enclosure 11; a constant light 14 mounted in the interior of the enclosure and thus constantly illuminating the interior of the sign enclosure; a one piece sign plate 12 made from a single layer of transparent material mounted in the enclosure, the sign plate having a first face 17 and an opposing second face, at least one inlaid cavity 22 (etched character) in the sign plate defining alpha-numeric indicia, the at least one cavity being closed by an integrally formed transparent window (portion) positioned across the second face, the alpha-numeric indicia of the sign plate bearing letters spelling the word EXIT, luminescent epoxy 16 filling the at least one inlaid cavity (col. 2, lines 56-59) between the first face and the second face resulting in the letters being formed with the luminescent epoxy, the at least one inlaid cavity of the sign plate being backlit via reflection by the light, such that the light illuminates the letters and activates the luminescent material so that the letters EXIT give off a luminescent glow making them visible when power to the light is

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disrupted. The first face 17 is being viewed and labeled as an “exterior facing” face, while the second face is being viewed and labeled as an “interior facing” face as these faces meet the claim limitations. It is noted the faces have no reference to limit the labeling of the faces of the sign plate. The cavity extends a distance “substantially” midway between the faces.

14. Regarding claim 19, wherein the at least one inlaid cavity 22 in the sign plate is formed in the exterior facing first face 17 and extends toward the interior facing second face of the sign plate.

15. Regarding claim 20, wherein at least a portion of the luminescent epoxy 16 filling the at least one inlaid cavity in the sign plate is located between the exterior facing first face 17 and the opposing interior facing second face of the sign plate.

16. Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woog (US#5607222).

17. Regarding claim 21, Woog discloses an exit sign comprising: a sign enclosure 12,16 defining an interior of the enclosure and having an opening communicating with an exterior of the sign enclosure; a light source 20 being mounted within the interior of the enclosure; and a one piece sign plate 14 being made from a single layer of material mounted in the enclosure, the sign plate having an exterior facing surface and an interior facing surface, and at least one cavity 18 (inscription, col. 2, lines 25-27) being formed and inlaid in the exterior facing surface and extending “substantially” midway between the exterior facing surface and the interior facing surface, the at least one cavity defining at least one alpha-numeric indicia, the sign plate having transparent portions only located between the at least one cavity and the interior facing surface

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(col. 2, lines 25-31), the at least one cavity being filled with a luminescent epoxy (luminescent paint, col. 2, lines 25-28) such that the luminescent epoxy forms the alpha-numeric indicia defined by the at least one cavity; and the light source directly illuminating the interior facing surface of the sign plate such that the light passes through the interior facing surface of the sign plate and then through the luminescent epoxy prior to exiting the sign enclosure.

18. Regarding claim 22, the light source is directly adjacent the interior facing surface of the sign plate such that light radiating from the light source constantly (continually recurring) illuminates the interior facing surface and the transparent portions of the sign plate to illuminate and charge the luminescent epoxy.

19. Regarding claim 23, Woog discloses an exit sign comprising: a sign enclosure 12,16 defining an interior of the enclosure and having an opening communicating with an exterior of the sign enclosure; a light source 20 being mounted within the interior of the enclosure; and a one piece sign plate 14 being made from a single layer of material mounted in the enclosure, the sign plate having an exterior facing surface and an interior facing surface, and first, second, third and fourth cavities 18 (inscription, col. 2, lines 25-27) being formed and inlaid in the exterior facing surface and extending “substantially” midway between the exterior facing surface, and the interior facing surface, the first cavity defining the letter E, the second cavity defining the letter X, the third cavity defining the letter I, and the fourth cavity defining the letter T, the sign plate having transparent portions only located between the at least one cavity and the interior facing surface (col. 2, lines 25-31), each of the first, the second, the third and the fourth cavities being filled with a luminescent epoxy (luminescent paint, col. 2, lines 25-28) such that the luminescent epoxy forms and spells EXIT; and the light source being directly adjacent the interior facing

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surface of the sign plate and directly and constantly (continually recurring) illuminating the interior facing surface of the sign plate such that the light passes through the interior facing surface of the sign plate and then through the luminescent epoxy prior to exiting the sign enclosure.

20. It is noted in claims 21-23, a constant light source is not being claimed as in claims 10 and 15.

### ***Response to Arguments***

21. The applicant argues Robinson '010 fails to meet claims 10 and 15 and argues the following:

22. "It is apparent that there are a number of distinctions between the teachings of Robinson '010 and the presently claimed invention. First, the etched characters 22 and consequently the photo-luminescent characters 16 are located on the rear inwardly facing surface 17 of the transparent panel 12. That is, on the surface of the panel 17 that faces the interior of the sign. This feature is in direct opposition to the pending claims in which the at least one cavity, and consequently the luminescent epoxy, are located on the exterior outwardly facing surface of the sign plate."

23. The examiner disagrees as the claims are broader than this argument. The faces of the sign plate are not currently claimed with respect to the sign enclosure. The sign enclosure is not even recited in claim 10. Moreover, there is no reference in claims 10 and 15 to limit the labeling of the opposing faces of the sign plate to that chosen by the applicant. Face 17 of Robinson '010 is capable of being labeled an "exterior facing" face, while the opposing face is thus capable of being labeled as an "interior facing" face.

24. Regarding claims 21 and 23, the examiner agrees the light source of Robinson '010 does not directly illuminate either face of the sign plate.



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Miller/  
Primary Examiner, Art Unit 3677